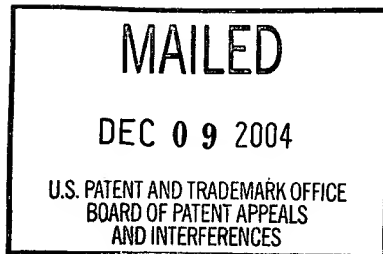


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte ANDREAS GIEFER

Appeal No. 2004-1606
Application No. 09/600,832

HEARD: December 8, 2004

Before COHEN, NASE, and BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 18 to 30, 32, 33 and 35 to 38, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention pertains to a slot cover of a shifting device of a motor vehicle transmission with a selector lever and a kinematics for transmitting the selection movements to a transmission, preferably an automatic transmission, with a movable louver, which covers at least one movement gate (shift gate, selection gate), and with a guide for the louver, wherein the louver has at least one opening for the passage of the selector lever (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Andronis¹

DE 197 28 548 A1

March 5, 1998

Claims 18 to 30, 32, 33, 35 and 38 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellant, at the time the application was filed, had possession of the claimed invention.

¹ In determining the teachings of Andronis, we will rely on the translation provided by the USPTO.

Claims 18 to 30, 32, 33 and 35 to 38 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 18 to 21, 24, 26 to 29, 36 and 37 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Andronis.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (mailed March 11, 2002) and the answer (mailed December 2, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (filed September 11, 2002) and reply brief (filed January 22, 2003) for the appellant's arguments thereagainst.

OPINION

Initially we note that issues 4-6 raised on pages 18-22 of the brief relate to petitionable matters and not to any appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review issues 4-6.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection under 35 U.S.C. § 112, first paragraph

We will not sustain the rejection of claims 18 to 30, 32, 33, 35 and 38 under 35 U.S.C. § 112, first paragraph.

The description requirement exists in the first paragraph of 35 U.S.C. § 112 independent of the enablement (how to make and how to use) requirement.² In the rejection (final rejection, p. 5) before us in this appeal under the first paragraph of 35 U.S.C. § 112 the examiner's statement of the rejection utilizes description requirement language (i.e., subject matter not described in the specification; that the appellant did not have possession of the claimed invention) but the body of the rejection utilizes enablement requirement language (i.e., unclear how applicant makes/uses).

² The description and enablement requirements are separate and distinct from one another and have different tests. See In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985); In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977); and In re Moore, 439 F.2d 1232, 1235-36, 169 USPQ 236, 239 (CCPA 1971).

Accordingly, we will look at both the description requirement and the enablement requirement.

In the final rejection (p. 5), the examiner found that the following claimed features violated 35 U.S.C. § 112, first paragraph: (1) the kinematics in claim 18; (2) the elastic louver portion in claim 27; (3) the signal transmitters and receivers in claims 32 and 35; (4) the permanent magnets and Hall sensors in claim 33; and (5) the bracket in claim 38.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

We have reviewed the original disclosure and find adequate written description support for (1) the kinematics in claim 18; (2) the elastic louver portion in claim 27; (3) the signal transmitters and receivers in claims 32 and 35; (4) the permanent

magnets and Hall sensors in claim 33; and (5) the bracket in claim 38. Accordingly, a rejection based on the written description requirement is not appropriate.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a nonenablement rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and

defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973). In making the determination of enablement, the examiner shall

consider the original disclosure and all evidence in the record, weighing evidence that supports enablement³ against evidence that the specification is not enabling.

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done. In fact, the examiner has made no attempt to demonstrate why undue experimentation would be required for a person of ordinary skill in the art to make/use (1) the kinematics in claim 18; (2) the elastic louver portion in claim 27; (3) the signal transmitters and receivers in claims 32 and 35; (4) the permanent magnets and Hall sensors in claim 33; or (5) the bracket in claim 38. Accordingly, we can not sustain a rejection based on the enablement requirement.

³ The appellant may attempt to overcome the examiner's doubt about enablement by pointing to details in the disclosure but may not add new matter. The appellant may also submit factual affidavits under 37 CFR § 1.132 or cite references to show what one skilled in the art would have known at the time of filing the application.

For the reasons set forth above, the decision of the examiner to reject claims decision of the examiner to reject claims 18 to 30, 32, 33, 35 and 38 under 35 U.S.C. § 112, first paragraph, is reversed.

The rejection under 35 U.S.C. § 112, second paragraph

We sustain the rejection of claims 37 and 38 under 35 U.S.C. § 112, second paragraph, but not the rejection of claims 18 to 30, 32, 33, 35 and 36.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner

of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

With this as background, we analyze the specific rejections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal.

In the final rejection (p. 6), the examiner found the following to be unclear:

- (A) which structures define the claimed elements such as: (1) the kinematics in claim 18; (2) the elastic louver portion in claim 27; (3) the slide rails in claim 29; (4) the signal transmitters and receivers in claims 32 and 35; and (5) the permanent magnets and Hall sensors in claim 33;
- (B) which structures define the claimed element "a louver guide" in claim 18;
- (C) which directions define the first and second directions in claim 36; and
- (D) whether claims 37 and 38 are dependent on claim 36 or not since claims 37 and 38 depend from claim A, however, there is no claim A.

We sustain the rejection of claims 37 and 38 under 35 U.S.C. § 112, second paragraph. The appellant has not specifically contested this rejection in the brief or reply brief. Moreover, claims 37 and 38 are indefinite since they fail to define the metes and bounds thereof with a reasonable degree of precision and particularity⁴ since claims 37 and 38 depend from claim A (a claim which does not exist). Thus, the scope of claims 37 and 38 is not known.

As to reasons (A)-(C), we fail to see how not knowing what particular structures define the various claimed elements or not knowing which specific directions define the first and second directions makes the scope of the claims unclear. In that regard, the mere breadth of a claim does not in and of itself make a claim indefinite.⁵ In our view, claims 18 to 30, 32, 33, 35 and 36 may be broad but they are definite since they define the metes and bounds thereof with a reasonable degree of precision and particularity as pointed out by the appellant in the briefs.

For the reasons set forth above, the decision of the examiner to reject claims 18 to 30, 32, 33 and 35 to 38 under 35 U.S.C. § 112, second paragraph, is affirmed with

⁴ See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

⁵ Breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

respect to claims 37 and 38 and reversed with respect to claims 18 to 30, 32, 33, 35 and 36

The anticipation rejection

We will not sustain the rejection of claim 18 to 21, 24, 26 to 29, 36 and 37 under 35 U.S.C. § 102(a) as being anticipated by Andronis.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claims 18 and 36 (the independent claims subject to this rejection) read as follows:

18. A motor vehicle transmission shifting device slot cover, the shifting device having a selector lever and kinematics for transmitting the selection movements to a transmission and at least one shift gate, the slot cover comprising:
a movable louver which covers the at least one shift gate, said louver having at least one opening for the passage of the selector lever, said louver being an endless band forming a closed loop;
a louver guide for guiding the movable louver;
a cover plate, said louver guide being moveable in relation to said cover plate at right angles to the direction of movement of the louver with respect to said louver guide.
36. A shifting device slot cover comprising:
a louver guide;
a louver movably connected to said louver guide in a first direction, said louver including an endless band forming a closed loop, said louver defining a selector lever opening;
a cover plate, said louver guide being movably connected to said cover plate in a second direction, said second direction being substantially perpendicular to said first direction.

Andronis' invention relates to a slot cover on the shifting path of a selection lever for a transmission. Figure 4 shows a cross section through a one variant of the slot cover, and Figures 5-7 show examples of a band-like slot cover element of the variant according to Figure 4.

In the Figure 4 variant of Andronis, the slot cover element is designed as an at least partially flat, annular, closed and flexible band 44. The band fully covers, with its flat part, the selection lever recess 3 formed in cowling 2 in each selection lever position and is guided around at least two, preferably four, rod-like guide elements 39, 40, 41,

42 arranged in rectangular form. These guide elements run in the direction of the longitudinal shifting path of the selection lever. Two guide elements 39, 40 are arranged along the two edge regions of the selection lever recess. The flexible band can then be made fully flat or, for reasons of saving material and using possibly another selection lever bushing on a lower band section, can consist of a flat slot cover element with thin bands attached to it that are joined on the end edges, for example, stitched. During displacement of the selection lever 6 in the longitudinal and/or transverse shifting direction, the band is then pushed, on the one hand, in the longitudinal shifting direction 13 (shown in Figure 1) axially along the guide elements and, on the other hand, guided around the guide element in the transverse shifting direction 10. During operation of the selection lever 6 in the direction of the transverse shifting path 10, the band 44 is entrained via bearing ball 15 and bearing cage 14 during simultaneous length compensation of selection lever 6 according to the movement and guided around the guide elements. The band 44 is also pushed to slide in the direction of the longitudinal shifting path 13 via guide elements 39-42 during operation of selection lever 6.

The appellant argues that claims 18 and 36 are not anticipated by Andronis because Andronis does not disclose a louver guide movably connected to the cover plate as claimed. We agree. While Andronis' band 44 corresponds to the recited

louver and Andronis' cowling 2 corresponds to the recited cover plate, Andronis does not teach any structure corresponding to the recited louver guide. The structure in Andronis that guides the louver in a first direction is Andronis' guide elements 39-42, however, guide elements 39-42 are fixed with respect to the cowling 2 since the band 44 slides axially along the guide elements when the selection lever 6 is shifted in the longitudinal shifting direction 13. Accordingly, Andronis' guide elements 39-42 are not movably connected to cowling 2.

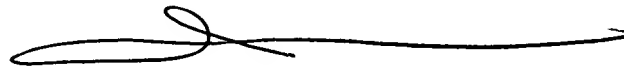
Since all the limitations of claims 18 and 36 are not met by Andronis for the reasons set forth above, the decision of the examiner to reject claims 18 and 36, and claims 19 to 21, 24, 26 to 29 and 37 dependent thereon, under 35 U.S.C. § 102(a) is reversed.

CONCLUSION

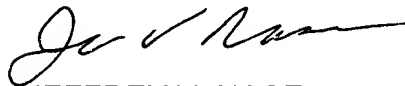
To summarize, the decision of the examiner to reject claims 18 to 30, 32, 33, 35 and 38 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 18 to 30, 32, 33 and 35 to 38 under 35 U.S.C. § 112, second paragraph, is affirmed with respect to claims 37 and 38 and reversed with respect to claims 18 to 30, 32, 33, 35 and 36; and the decision of the examiner to reject claims 18 to 21, 24, 26 to 29, 36 and 37 under 35 U.S.C. § 102(a) is reversed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART



IRWIN CHARLES COHEN
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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